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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/493,545	01/28/2000	Renwen Zhang	GI 5340A	2389

25291 7590 01/29/2002

AMERICAN HOME PRODUCTS CORPORATION  
FIVE GIRALDA FARMS  
PATENT LAW  
MADISON, NJ 07940

EXAMINER

ROBINSON, HOPE A

ART UNIT PAPER NUMBER

1653

DATE MAILED: 01/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/493,545

Applicant(s)

ZHANG ET AL.

Examiner

Hope A. Robinson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 October 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 30 October 2001. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-21.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other:

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### **DETAILED ACTION**

1. Applicant's response to the Final Office Action mailed April 30, 2001 in Paper No. 11 on October 30, 2001 is acknowledged.

2. Applicant's arguments filed October 30, 2001 have been fully considered but are not persuasive.

The rejection under 35 U.S.C. 103(a) over claims 1-21 has been maintained.

3. Claims 8, 9 and 12 have been amended. Claims 1-21 are pending.

4. Claims 1-21 remain rejected under 35 U.S.C. 103(a) because the amendments to the claims was not sufficient to overcome this ground of rejection. Applicant's response contends that Hattersley et al. disclosure requires parathyroid hormone in combination with BMP-2. However, the cited reference remains relevant to the claimed invention as the open language of "comprising" is used. Note that the claimed method and composition do not exclude the use of a parathyroid hormone. The claims are directed to a method that comprising administering an effective amount of BMP and the method does not exclude other components that could be added to BMP. The prior office action in Paper No. 7 stated that "the claims contain the word

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“comprising” which is an open term and thus any art that is identified can have BMP plus any other components and still read on the claim if it is being used for cartilage repair”. Applicant’s arguments did not address this statement made by the previous examiner. Applicant merely argues that the combination of PTHrP and BMP is used in the reference. The response further argues that the Nevo et al reference alone or in combination teaches the claimed invention. This argument is not persuasive as the references combined render the claimed invention as obvious, because Nevo teaches compositions for repairing damaged cartilage (chondrocytes and other growth factors) and Hattersley teach methods and compositions for repairing, reducing or preventing damage to cartilage and cartilaginous tissues. Hattersley also teach that BMP-2 has been shown to be able to induce the formation of new cartilage and or bone tissue in vivo in a rat ectopic implant model (see column 1). Therefore, applicant’s arguments are not persuasive and the rejection remains.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope Robinson whose telephone number is (703) 308-6231. The examiner can normally be reached on Monday and Wednesday-Friday from 9.00 am to 5.30 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Christopher S.F. Low, Ph.D., can be reached at (703) 308-2923.

Any inquiries of a general nature relating to this application should be directed to the Group Receptionist whose telephone number is (703) 308-0196.

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Papers related to this application may be submitted by facsimile transmission. The official fax phone number for Technology Center 1600 is (703) 308-4242. Please affix the examiner's name on a cover sheet attached to your communication should you choose to fax your response. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Hope Robinson, MS 

Patent Examiner

  
KAREN COCHRANE CARLSON, PH.D  
PRIMARY EXAMINER